



Attorney Docket No.: 22841-018

PATENT

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GROUP 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Paul NICHOLSON, et al.

Serial No: 09/640,526

Filed: August 17, 2000

For: EXTENDED WEAR OPHTHALMIC LENS

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) Group Art Unit: 1714
)
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) Examiner: Edward Cain
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TRANSMITTAL LETTER

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Petition to Expunge Information in an Application Under the Provisions of 37 C.F.R. § 1.59 and MPEP 724.05 in the above-identified application. Please charge the Petition filing fee of \$130.00 to Deposit Account No. 500417. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 500417.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Date: June 26, 2003

By

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Applicant File No. 22841.018

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Mail Stop MPEP
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**Petition to Expunge Information in an Application
Under the Provisions of 37 C.F.R. § 1.59 and MPEP 724.05**

Dear Sir:

Under the provisions of 37 C.F.R. § 1.59, and MPEP § 724.05, Petitioner Nicolson et al. (and Ciba Vision, Corporation as assignee of the above identified patent) request that the expert "Preliminary Report of Dr. William Daly, 6/24/02 and Nonpublicly Available Exhibits to Daly Report, 6/24/02," *Ciba Vision Corp. et al. v. Bausch & Lomb Incorporated*, Civil Action No. 99-0034-RWS, U.S. District Court for the Northern District of Georgia, filed in an Information Disclosure Statement dated November 18, 2002, be *expunged* from the record for the reasons set forth herein.

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Background Information

By way of background information, the assignee of the present application, Ciba Vision, is engaged in a patent infringement suit against Bausch & Lomb, entitled *Ciba Vision Corp. et al. v. Bausch & Lomb Incorporated*, Civil Action No. 99-0034-RWS, in the U.S. District Court for the Northern District of Georgia, Gainesville Division. In this suit, Ciba Vision has asserted that Bausch & Lomb has infringed at least one of the claims of Nicolson et al.'s reexamined U.S. Patent Nos. B1 5,760,100; B1 5,849,811 and B1 5,789,461. In defense of these infringement allegations, Bausch & Lomb has provided a report in which one of its experts, Dr. Daly, contends that the claims of Nicolson *et al.*'s patents are invalid for various reasons, *e.g.*, that Nicolson *et al.* violated the best mode requirement of 35 U.S.C. § 112, 1st paragraph, and that the claimed inventions are invalid under the provisions of 35 U.S.C. §§ 102(a), 102(b) and §102(g).¹ Dr. Daly bases his 35 U.S.C. §§ 102(a), 102(b) and §102(g) invalidity arguments in large part on a number of exhibits attached to his report, which exhibits set forth in part Bausch & Lomb's own work on its own contact lens product.

The present application is a continuation patent application that claims priority under 35 U.S.C. § 120 from at least one of the parent patent applications - U.S. Patent Nos. B1 5,760,100 (SN 08/569,816); and B1 5,849,811 (SN 08/682,452).² In the office action mailed on March 22, 2002, the examiner rejected the pending claims of the present application under the judicially created doctrine of obviousness double patenting as being unpatentable over all claims of U.S. Pat. No. 5,760,100, among other patents.

¹ Dr. Daly serves as Bausch & Lomb's technical expert in polymer chemistry.

Paper No. 11. In response, Ciba Vision filed a terminal disclaimer in regard to U.S. Pat. No. B1 5,760,100, among other patents. Due to the judicially created obviousness type double patent rejection, any invalidity arguments submitted by Bausch & Lomb in regard to U.S. Pat. No. B1 5,760,100 may be considered to be material to the examination of the present application under the provisions of 37 U.S.C. § 1.56.

To fulfill its duty of disclosure requirements to the Office under 37 C.F.R. § 1.56, Ciba Vision submitted an Information Disclosure Statement to the Office on September 23, 2002, which presented Bausch & Lomb's 35 U.S.C. § 102(a), (b) and (g), and 35 U.S.C. § 112, 1st paragraph invalidity arguments³. This IDS submission included the expert preliminary report of Dr. Daly, who asserted the invalidity of the above "B1" reexamined patents under the provisions of 35 U.S.C. § 102(a), (b) and (g). A supplemental Information Disclosure Statement was submitted to the Office on November 18, 2002 to invoke the provisions of MPEP § 724.02. On December 10, 2002, the examiner indicated that all claims were allowable, and initialed the "Form 1449" IDS listing submitted on September 23, 2002 and November 18, 2002.

However, after these materials were submitted to the Patent Office, Ciba Vision's trial counsel in the U.S. District Court action brought to prosecution counsel's attention that certain materials submitted to the Patent Office contain Bausch & Lomb

² Each is an asserted patent by Ciba Vision in the U.S. District Court.

³ Previously, Ciba Vision had submitted extensive Information Disclosure Statements that reflect other prior invalidity arguments that were earlier asserted by Bausch & Lomb

information marked "confidential" under a Protective Order entered in the U.S. District Court action and were submitted to the Office without the requisite approval of Bausch & Lomb. After disclosing these events to Bausch & Lomb and in light of the Protective Order restricting disclosure of the producing party's confidential information, Ciba Vision agreed to take appropriate steps to have Bausch & Lomb's "Confidential" designated materials expunged from the pending application file.

Accordingly, Ciba Vision now requests that the "Preliminary Expert Report of Dr. William Daly, 6/24/02 *et seq.*" be expunged from the file. By expunging Dr. Daly's report, Ciba Vision and Bausch & Lomb will have the ability to review Dr. Daly's report and determine what information in Dr. Daly's report is necessary and material for the examination of the subject patent application. Ciba Vision and Bausch & Lomb will confer to determine if particular information may be redacted from Dr. Daly's report such that a redacted copy of his report may be submitted to Office in a timely manner.

If Ciba Vision and Bausch & Lomb cannot agree on the appropriate handling of all or a part of Dr. Daly's report (such as the form and content) for presentation to the Office under the provisions of 37 C.F.R. § 1.56, Ciba Vision will take the necessary steps to seek intervention of the Gainesville district court, which should

in the U.S. District Court proceedings and before the Office during the reexamination proceedings of the above Ciba Visions patents.

enable Ciba Vision to allow the Office to have the benefit of such information.⁴ In a like manner, Bausch & Lomb will also have the opportunity to present their position to the district court as the form and content necessary to present Dr. Daly's preliminary expert report to the Office.

For the above reasons , Ciba Vision has determined that it is appropriate and necessary under the Protective Order entered by the U.S. District Court for Ciba Vision to tender this petition to expunge the Dr. Daly's preliminary expert report,⁵ together with its supporting exhibits.

Case Status

On March 10, 2002, Ciba Vision did file a Request for Continuing Examination ("RCE") in this case, which included four newly added claims. A three month suspension was requested in in the RCE. Ciba Vision did not pay the issue fee due on March 10, 2003.

⁴ During the reexamination proceedings of U.S. Patent Nos. B1 5,760,100, B1 5,849,811 and B1 5,789,461 (now being asserted by Ciba Vision against Bausch & Lomb), Ciba Vision did seek and obtain the intervention of the U.S. district court in order to present information obtained from Bausch & Lomb during the Gainesville court proceeding to the Office.

⁵ It is noted that is not necessary for Ciba Vision to seek redaction of Bausch & Lomb's alleged invalidity arguments as to best mode under 35 U.S.C. § 112, first para., as the information that Bausch & Lomb is using for its invalidity arguments (and under protective order) owes its origin to Ciba Vision, not Bausch & Lomb. For the reasons set forth in the background of this petition, Ciba Vision submitted this information to fulfil its duty of disclosure under 37 C.F.R. § 1.56.

Identification of the Information to be Ex Punged.

The identification of the information to be expunged is as follows:

Preliminary Report of Dr. William Daly, 6/24/02 and Nonpublicly Available Exhibits to Daly Report, 6/24/02.

Bausch & Lomb fairly has indicated that the information to be expunged is proprietary to Bausch & Lomb, and that such material appears to be under Protective Order of the U.S. District Court for the Northern District of Georgia, Gainesville Division.

The Information to be Expunged is Trade Secret Information, Proprietary Information, and/or Subject to Protective Order and/or the Information has Otherwise Not Been Made Available to the Public.

Bausch & Lomb has advised Ciba Vision that the parts of Dr. Daly's preliminary report to be expunged are proprietary to Bausch & Lomb, that the information is subject to a Protective Order issued by the U.S. District Court, and that such proprietary information has not otherwise been made available to the public.

Commitment on Ciba Vision to Retain Such Information for The Period of the Patent.

As petitioner, Ciba Vision, does make the commitment to retain such information for the period of the patent and six years beyond; provided however, due to the Protective Order of the U.S. District Court, Ciba Vision may need to return or destroy such the information upon final resolution of the infringement matter in U.S. District

Court. In this regard, Ciba Vision has reached agreement with Bausch & Lomb where Bausch & Lomb will either agree to allow Ciba to maintain such information for the term of the patent and six years beyond , and/or that Bausch & Lomb will provide such information to Ciba Vision for the term of the patent and six years beyond, if the Office requests such information.

Ciba Vision is the Party in Interest Who Originally Submitted the Information.

In fulfilment of its duty of candor under Rule 56, Ciba Vision is the party in interest who originally submitted the information to be expunged.

The Fee Set Forth in 37 C.F.R. 1.17(i).

Petitioner, Ciba Vision, hereby authorizes the Office to charge deposit Account No. the fee of \$130.00 for this petition under 37 C.F.R. § 1.59(b).

Argument.

Petitioner, Nicolson et al. (by and for Ciba Vision) requests that this petition to ex punge be granted for the following reasons. In the pending patent infringement action in U.S. District Court, Bausch & Lomb presented information that the patents asserted by Ciba Vision's against Bausch & Lomb are invalid under the provisions of 35 U.S.C. § 112, 1st paragraph, and 35 U.S.C. §§ 102(a), 102(b) and §102(g).

To comply with its duty of disclosure Ciba Vision filed an Information Disclosure Statement that included the above-described materials. However, Dr. Daly's report is under a court imposed protective order by the U.S. District Court in Georgia. Dr. Daly's report is in part based upon information that has been designated by B&L as "confidential" under the protective order. Accordingly, the subject materials should be expunged.

A complete copy of Dr. Daly's report will be maintained by either Ciba Vision or Bausch & Lomb (who will convey the same to Ciba Vision if required by the Office). Ciba Vision is committed to use its best efforts to reach a resolution with Bausch & Lomb that will allow CIBA to resubmit all potentially material information contained in the Daly report. If the parties are unable to agree to an appropriate submission of Dr. Daly's report to the Office that will fairly convey the merits and substance of Bausch & Lomb's 102(a), (b) and (g) invalidity arguments, then Ciba Vision is committed to seek the intervention of the district court to fulfil its responsibilities under 37 C.F.R. § 1.56.⁶

* * * * *

⁶ To the extent Bausch & Lomb is presenting invalidity arguments to the U.S. District Court on the parent patent claims, Ciba Vision will take the necessary and appropriate steps to assure that such arguments are before the Office as to the "obvious type double patent claims" in the child application.

Petitioner hereby prays that the petition to expunge Dr. Daly's preliminary expert report be granted. To the extent an interview will clarify any issues now before the Examiner, the applicant will be pleased to interview and confer with the examiner on this matter.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Dated: June 26, 2003

By: 

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